

**REMARKS**

Claims 1, 2, and 4-9 are pending and under consideration. Claims 1 and 4 are amended herein. Claim 3 is cancelled herein, without prejudice or disclaimer. Support for the amendments to the claims may be found in the claim 3 as originally filed, as well as at page 8, lines 21-25, continuing at page 9, line 1 of the specification. Reconsideration is requested based on the foregoing amendment and the following remarks.

**Response to Arguments:**

The Applicants appreciate the consideration given to their arguments, and the withdrawal of the previous grounds of rejection. Further favorable consideration is requested.

**Claim Rejections - 35 U.S.C. § 102:**

Claims 1, 2, and 4-9 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,529,942 to Gilbert (hereinafter "Gilbert"). The rejection is traversed to the extent it would apply to the claims as amended.

The third clause of claim 1 recites:

Storing keyword information predetermined for respective receivers, wherein the keyword information is designated by the sender and different for respective receivers.

Gilbert neither teaches, discloses, nor suggests "storing keyword information predetermined for respective receivers, wherein the keyword information is designated by the sender and different for respective receivers," as recited in claim 1. Gilbert, rather, mentions no keywords at all.

The Office Action acknowledges this deficiency of Gilbert at page 8, saying:

However, Gilbert does not teach a storing device storing keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Krause.

To the contrary, Gilbert teaches away from the modification proposed in the Office Action at column 1, lines 36 and 37 when he illustrates a problem with then-current technology as requiring "three different versions of the same message are created and sent by the office manager." Gilbert then provides, at column 1, lines 38-43, that

Therefore, what is needed is an electronic mail system that allows an originating user to customize a message based on who the receiver is without the originating

user having to generate multiple versions of the original message for other recipients.

"Storing keyword information predetermined for respective receivers, wherein the keyword information is designated by the sender and different for respective receivers," on the other hand, would inter alia allow an originating user to generate multiple versions of the original message for other recipients based on who is the receiver, i.e. precisely what Gilbert does *not* want to do. Thus, far from being an obvious modification of Gilbert, those of ordinary skill in the art at the time the invention was made lacked, apparently, the imagination to perceive the benefits of "storing keyword information predetermined for respective receivers, wherein the keyword information is designated by the sender and different for respective receivers," as recited in claim 1.

The keywords in Krause, furthermore, are not "predetermined for respective receivers," or "designated by the sender and different for respective receivers," as recited in claim 1, at all. The keywords in Krause, rather, are selected by the *user*, as described in Krause at column 3, lines 59-63:

Another object of the present invention is to provide a reader the ability to have certain words stand out from less important words. At the user's option, this distinction can be based on parts of speech, such as the nouns or verbs that constitute the backbone of a text. Alternatively, specific words can be emphasized based on their location within the text or location on the computer display.

Since the keywords in Krause are selected by the user, rather than "designated by the sender and different for respective receivers," as recited in claim 1, Krause could not make up for the deficiencies of Gilbert in any case.

The fourth clause of claim 1 recites:

An emphasizing device emphasizing and highlighting different parts of the transmission information for respective receivers, the different parts including respective keyword information for respective receivers stored by the storing device.

Gilbert neither teaches, discloses, nor suggests "an emphasizing device emphasizing and highlighting different parts of the transmission information for respective receivers, the different parts including respective keyword information for respective receivers stored by the storing device," as recited in claim 1. No keywords are mentioned in Gilbert at all, as discussed above.

The fifth clause of claim 1 recites:

Transmitting the E-mail information including all of the transmission information to

all respective receivers.

Gilbert neither teaches, discloses, nor suggests “transmitting the E-mail information including all of the transmission information to all respective receivers,” as recited in claim 1. In Gilbert, rather, each recipient receives all the inserted format commands that were *encoded*, not “all of the transmission information,” as recited in claim 1. In particular, as described at column 9, lines 14-18:

In this embodiment, each recipient receives all the inserted format commands that were encoded but their data processing system 20 only decodes the inserted format commands relevant to them.

Since, in Gilbert, each recipient only receives the inserted format commands that were encoded, Gilbert is not “transmitting the E-mail information including all of the transmission information to all respective receivers,” as recited in claim 1.

Furthermore, in Gilbert, recipients receive different format codes that individually customize the message sent to them. Thus, each recipient receives the same *message*, but with unique formatting. In particular, as described at column 8, lines 48-57:

By following the steps outlined in FIGS. 2 and 3, Tom uses the software to insert format codes such that each recipient receives the same message but with individual customized modifications. For example, the message represented in block 164 is received by John with his portion of the message 162 highlighted in bold. When Mary receives the message represented in block 166, her portion of the message 162 is underlined. Likewise, when Harry receives the message 162, his portion of the message is in bold, as represented in block 168.

Since, in Gilbert, each recipient receives different format codes that individually customize the message for them, Gilbert is not “transmitting the E-mail information including all of the transmission information to all respective receivers,” as recited in claim 1.

Finally, in Gilbert, individual modifications corresponding to a particular recipient are received only by that recipient, rather than “transmitting the E-mail information including all of the transmission information to all respective receivers,” as recited in claim 1. In particular, as described at column 9, lines 1-4:

In this embodiment, each recipient receives all the inserted format commands that were encoded but their data processing system 20 only decodes the inserted format commands relevant to them.

Since, in Gilbert, individual modifications corresponding to a particular recipient are received only by that recipient, Gilbert is not “transmitting the E-mail information including all of the

transmission information to all respective receivers," as recited in claim 1. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claim 2 depends from claim 1 and adds further distinguishing elements. Claim 2 is thus also submitted to be allowable. Withdrawal of the rejection of claim 2 is also earnestly solicited.

Claim 4:

The second clause of claim 4 recites:

Keyword information predetermined for respective receivers, wherein the keyword information is designated by a sender and different for respective receivers.

Gilbert neither teaches, discloses, nor suggests "keyword information predetermined for respective receivers, wherein the keyword information is designated by a sender and different for respective receivers," as discussed above with respect to the rejection of claim 1.

The third clause of claim 4 recites:

Indicating e-mail information that emphasizes and highlights different parts of the transmission information for respective receivers, the different parts including respective keyword information for respective receivers.

Gilbert neither teaches, discloses, nor suggests "indicating e-mail information that emphasizes and highlights different parts of the transmission information for respective receivers, the different parts including respective keyword information for respective receivers," as discussed above with respect to the rejection of claim 1.

The third clause of claim 4 recites further:

With all of the transmission information sent to all respective receivers.

Gilbert neither teaches, discloses, nor suggests "with all of the transmission information sent to all respective receivers," as discussed above with respect to the rejection of claim 1. Claim 4 is submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 4 is earnestly solicited.

Claims 5-8:

Claims 5-8 recite substantially:

Transmitting the E-mail information including all of the transmission information to all respective receivers.

Gilbert neither teaches, discloses, nor suggests "transmitting the E-mail information including all

of the transmission information to all respective receivers," as discussed above with respect to the rejection of claim 1. Claims 5-8 are submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claims 5-8 is earnestly solicited.

Claim 9:

The fourth clause of claim 9 recites:

Sending all of the information by email to all the destinations with each destination receiving all of the information.

Gilbert neither teaches, discloses, nor suggests "sending all of the information by email to all the destinations with each destination receiving all of the information," as discussed above with respect to the rejection of claim 1. Claim 9 is submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 9 is earnestly solicited.

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 2, and 3-9 are allowable over the cited references. Allowance of all claims 1, 2, and 3-9 and of this entire application is therefore respectfully requested.

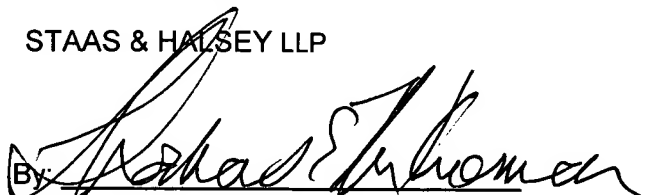
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 10MY06

By:   
Thomas E. McKiernan  
Registration No. 37,889

1201 New York Avenue, NW, 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501